

ESTTA Tracking number: **ESTTA558177**

Filing date: **09/06/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Cosmetic Warriors Limited		
Entity	Corporation	Citizenship	United Kingdom
Address	29 High Street Poole, Dorset, BH15 1AB UNITED KINGDOM		

Attorney information	John A. Clifford Merchant & Gould P.C. PO Box 2910 Minneapolis, MN 55402-9944 UNITED STATES jclifford@merchantgould.com, aavery@merchantgould.com, dockmpls@merchantgould.com Phone:612.336.4616
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Applicant Information

Application No	85887393	Publication date	08/13/2013
Opposition Filing Date	09/06/2013	Opposition Period Ends	09/12/2013
Applicant	Wells, Sir Killian, Mathew 15401 Keswick St Van Nuys, CA 91406 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Caffeine preparations for stimulative use; Herbal supplements for boosting energy and relaxation; Vitamin supplement in tablet form for use in making an effervescent beverage when added to water

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2853483	Application Date	11/25/2002
Registration Date	06/15/2004	Foreign Priority Date	08/14/2002

Word Mark	LUSH
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries

U.S. Registration No.	3001303	Application Date	04/27/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1996/05/00 First Use In Commerce: 1996/06/00 Catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags		

U.S. Registration No.	2282428	Application Date	02/25/1997
Registration Date	10/05/1999	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 perfumes; non-medicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, [dentifrices, cosmetic depilatory creams,] personal deodorants, preparations for the care of the hair, shampoos, soaps [, and essential oils for personal use] Class 005. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 [medicated hair care, skin care, teeth care and nail care preparations]		

U.S. Registration No.	3102767	Application Date	01/06/2005
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	LUSH FRESH HANDMADE COSMETICS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1996/06/00 First Use In Commerce: 2002/12/00 Perfumes; non-medicated toilet and cosmetic preparations, namely lotions,		

	powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use
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U.S. Registration No.	3008685	Application Date	04/27/2004
Registration Date	10/25/2005	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 Perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid skin moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use		

U.S. Registration No.	3987808	Application Date	11/04/2005
Registration Date	07/05/2011	Foreign Priority Date	06/21/2005
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: Hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; Beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; Beauty salon services; Aromatherapy services; Skin care salon services; Massage services; Nail care and manicure services; Trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; Counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty demonstrations		

U.S. Registration No.	4118438	Application Date	08/09/2011
Registration Date	03/27/2012	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 Cosmetics

Attachments	2013 09 06 Notice of Opposition.PDF(323435 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A. Clifford/
Name	John A. Clifford
Date	09/06/2013

Mark: **LUSH**

International Class 5: Caffeine preparations for stimulative use; Herbal supplements for boosting energy and relaxation; Vitamin supplement in tablet form for use in making an effervescent beverage when added to water

This application (Serial No. 85/887,393) is based on Applicant's intent-to-use of the mark in commerce.

2. Applicant's Mark published for opposition on August 13, 2013. This Notice of Opposition is timely filed.
3. Opposer is the owner of the following U.S. Trademark Registrations:

LUSH, U.S. Reg. No. 2,853,483, used in connection with bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries, in International Class 35. Said registration was registered on the Principal Register on June 15, 2004 and was based on a foreign registration filed in the United Kingdom on August 14, 2002, which is a date prior to the date of filing of Applicant's application.

LUSH, U.S. Reg. No. 3,001,303, used in connection with catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags, in International Class 16. Said registration registered on the Principal Register on September 27, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on April 27, 2004 alleging a date of first use of May 1996, which is a date prior to the date of filing of Applicant's application.

LUSH, U.S. Reg. No. 2,282,428, used in connection with perfumes; non-medicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, dentifrices, cosmetic depilatory creams, personal deodorants, preparations for the care of the hair, shampoos, soaps, and essential oils for personal use, in International Class 3. Said registration was registered on the Principal Register on October 5, 1999 and was based on an application filed in the U.S. Patent and Trademark Office on February 25, 1997 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application. This registration is also incontestable.



, U.S. Reg. No. 3,102,767, used in connection with perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid moisturizers and skin

conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use, in International Class 3. Said registration registered on the Principal Register on June 13, 2006 and was based on an application filed in the U.S. Patent and Trademark Office on January 6, 2005 alleging a date of first use of June 1996, which is a date prior to the date of filing of Applicant's application.

LUSH, U.S. Reg. No. 3,008,685, used in connection with perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid skin moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use, in International Class 3. Said registration registered on the Principal Register on October 25, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on April 27, 2004 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application.

LUSH, U.S. Reg. No. 3,987,808, for hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; beauty salon services; aromatherapy services; skin care salon services; massage services; nail care and manicure services; trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty demonstrations, in International Class 44. Said registration registered on the Principal Register on July 5, 2011 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application.

LUSH, U.S. Reg. No. 4,118,438, for cosmetics in International Class 3. Said registration registered on the Principal Register on October 25, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on March 27, 2012 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application.

4. Opposer's registered marks are valid and subsisting, and are prima facie evidence of Opposer's exclusive right to use said mark in commerce on the goods and services specified in each registration. In addition, Reg. Nos. 2,853,483 and 2,282,428, are

incontestable under §15 of the Lanham Act (15 U.S.C. §1065), and are therefore conclusive evidence of the validity of the registered marks, of registration of the marks, of Opposer's ownership of the marks, and of Opposer's exclusive right to use the marks in commerce under §33(b) of the Lanham Act (15 U.S.C. §1115(b)).

5. Since at least as early as April 10, 1995, Opposer has used the LUSH mark in the United States. Said use has been continuous since the date of first use and has not been abandoned.
6. Opposer has for many years sold caffeinated products, such as shower gel made with caffeine, lime juice, and chocolate. Opposer also sells a wide variety of bath products for boosting energy, promoting relaxation or treating hangovers.
7. Opposer has advertised and promoted its LUSH mark extensively. Opposer has also made substantial sales under said mark. As a result of such use and promotion, Opposer's LUSH mark has developed and represents valuable goodwill inuring to the benefit of Opposer. Opposer operates over 105 brick-and-mortar retail stores in at least 33 states under its LUSH trademark in the United States, and will soon open more stores. Opposer operates nearly 800 stores worldwide. Opposer also makes substantial sales of its products through its online retail store at www.lushusa.com.
8. Opposer has priority with respect to the mark at issue in this opposition. Opposer has had priority of use of the LUSH mark long before the March 27, 2013 filing date of Applicant's application.
9. Applicant's LUSH mark is confusingly similar to Opposer's LUSH marks. The marks have an overall confusingly similar appearance, sound, meaning and commercial impression. Applicant's goods are highly and closely related to Opposer's goods and services. Applicant's mark suggests a connection between Opposer and Applicant that does not exist.

10. Applicant's mark is deceptively similar to Opposer's marks. The marks are identical. The marks have a confusingly similar appearance, sound, meaning and commercial impression. Consumers will mistakenly believe that Applicant's goods are offered by, affiliated with and/or sponsored by Opposer when the same is not true.
11. Due to the highly similar nature of Applicant's mark and Opposer's marks, the closely related nature of the goods provided by the respective parties, consumers and potential consumers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.
12. The use and registration by Applicant of the mark LUSH for Applicant's goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with Opposer's previously used LUSH marks, again resulting in damage to Opposer.
13. Because of the highly related nature of the goods, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, use and registration of the term LUSH by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.
14. Opposer's LUSH mark is famous and distinctive, and was famous prior to any first use of LUSH mark by Applicant. Use and registration of LUSH mark by Applicant will cause dilution by blurring and impair the distinctiveness of Opposer's mark.
15. If Applicant is granted registration of the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer, and could bar Opposer from obtaining a registration of its LUSH mark.

16. Registration of the mark shown in Application Serial No. 85/887,393, will result in damage to Opposer under the provisions of §2(a), §2(d) §43(c) and of the U.S. Trademark Act, 15 U.S.C. § 1052, §1125 pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that the registration of the proposed mark LUSH set forth therein be refused. Please direct all correspondence to the attention of:

John A. Clifford
Merchant & Gould P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
Tel: 612-336-4616 Fax: 612-332-9081

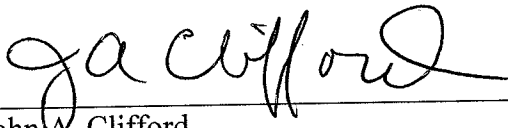
Opposer hereby appoints: John A. Clifford; Danielle I. Mattessich; Heather Kliebenstein, Brian H. Batzli; Gregory C. Golla; Scott W. Johnston; Andrew S. Ehard; Christopher J. Schulte; and Brent Routman as its attorneys with the full power to represent the Opposer in connection with this proceeding.

Respectfully submitted,

COSMETIC WARRIORS LIMITED,

By its attorneys,

Date: Sept 6, 2013

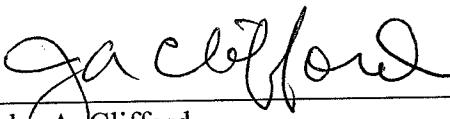


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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **NOTICE OF
OPPOSITION** was served, via first-class mail, postage prepaid this 6th day of September 2013.

Sir Killian Mathew Wells
15401 Keswick St
Van Nuys, CA 91406-2009



John A. Clifford